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| 09/987,337      | 11/14/2001  | Munetaka Tsuda       | 500.40852X00        | 6871             |

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EXAMINER

SHAH, DEVAANG

ART UNIT PAPER NUMBER

3737

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/987,337

Applicant(s)

TSUDA, MUNETAKA

Examiner

Devaang Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 13 and 15 is/are rejected.
- 7) ☒ Claim(s) 5-8 and 14 is/are objected to.
- 8) ☒ Claim(s) 9-12 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8 and 13-15, drawn to a magnetic resonance imaging apparatus, classified in class 600, subclass 410.
- II. Claims 9-12, drawn to a method of assembling a magnetic resonance imaging apparatus, classified in class 29, subclass 607.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. Invention I is a magnetic resonance imaging apparatus, which has the function of producing magnetic resonance images. Invention II is a method of assembling a magnetic resonance imaging apparatus, which has the function of production of magnetic resonance imaging devices.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Melvin Kraus on 6 March 2003, a provisional election was made without traverse to prosecute the invention of group I, claims 1-8 and 13-15. Affirmation of this election must be made by applicant in replying

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to this Office action. Claims 9-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

Claim 2 is objected to because of the following informalities: in line 2, after "to claim," no claim number is specified. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,357,958 to Kaufman in view of U.S. Patent No. 5,014,070 to Danby et al. Kaufman discloses an open MRI system that consists of a pair of magnet devices in face-to-face relation with each other for accommodating an examinee; a gradient field generating device; a high-frequency generating device; and a yoke for combining the magnetic devices to form a closed magnetic circuit. The magnetic devices may consist of superconducting magnetic devices (column 3, lines 53-68; column 4, lines 1-43; figure 1). However, Kaufman does not delve into the structure of the yoke.

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Danby et al. disclose ferromagnetic yoke magnets for MRI studies. The yoke includes a first plate member and a second plate member, and support post members interconnecting the plate members. Shim bars are disposed on the pole faces to minimize leakage field strength and increase the volume of uniform magnetic field (columns 3-8; figures 1-7). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the yoke assembly disclosed by Danby et al. with the MRI system disclosed by Kaufman because Kaufman utilizes a yoke with magnetic devices in face-to-face relation, as does Danby et al., and such yoke structures are well known in the art.

### ***Allowable Subject Matter***

Claims 5-8 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent No. 6,225,805 B1 to Damadian et al.

U.S. Patent No. 5,917,395 to Overweg

U.S. Patent Application Publication No. US 2002/0123681 A1 to Zuk et al


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devaang Shah whose telephone number is 703-306-0333. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on 703 308-3256. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

DS  
March 8, 2003



Marvin M. Lateef  
Supervisory Patent Examiner  
Group 3700